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Paper No. 46

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MAY 14 2004

OFFICE OF PETITIONS

In re Application of	:	
Curtis Priem, Gopal Solanki, and David Kirk	:	
Application No. 09/056,656	:	
Filed: April 7, 1998	:	DECISION ON PETITION
Attorney Docket No. NV30	:	UNDER 37 C.F.R. §1.182
Title: TEXTURE CACHE FOR A	:	
COMPUTER GRAPHICS ACCELERATOR	:	

This is in response to the petition filed December 30, 2003, under 37 C.F.R. §1.182, requesting that a declaration of facts under 37 C.F.R. §1.131 be accepted without the signature of one of the three affiants¹.

On July 2, 2003, the Office issued a non-final rejection. Petitioner wishes to submit an affidavit/declaration of facts to swear behind the rejection and establish prior invention.

Unfortunately, the assignee, Nvidia Corporation, has determined that joint inventor Priem is unwilling to execute the §1.131 declaration. Therefore, the granting of a petition under 37 C.F.R. §1.182 is required before the affidavit is accepted, since less than all of the named affiants will be signing the document.

In order for this petition to be granted, Petitioner will need to establish the following four three requirements:

- (1) The petition fee;
- (2) a statement of the last known address of each of the non-signing inventors, and;
- (3) proof that a copy of the entire application (specification, claims, drawings,

¹ The three affiants are the three joint inventors, and it is alleged that the first named inventor has refused to sign the §1.131 declaration.

and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application.

With the instant petition, Petitioner has submitted the petition fee, a §1.131 declaration executed by two of the three joint inventors, a statement of facts from an attorney not of record, a copy of a letter which was sent to the non-signing joint inventor, a copy of an e-mail sent from Federal Express, and a copy of a letter sent by one who is purported to be the legal representative of the non-signing joint inventor. Petitioner has also submitted a three-month extension of time to make timely this response.

Petitioner has met requirements (1) and (2) above.

Regarding the third requirement above, Petitioner has not established that a complete copy of the application papers was sent to the non-signing inventor. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration².

Petitioner has included a copy of a letter dated December 1, 2003, which was sent to the non-signing inventor, and a copy of an e-mail from Federal Express which confirms that the package was signed for by one "P.Riem³." Unfortunately, it does not appear that the Petitioner mailed a complete copy of the instant application:

- The Office records show that application number 09/056,656 is associated with an attorney docket number of NV30.
- The Office records have been determined to be correct, as this attorney docket number was received from the §1.63 declaration submitted on filing, which lists the attorney docket number as NV30.
- For reasons that are not clear, the attorney docket number on the instant petition is listed as NVID-001/00US.
- The copy of the letter dated December 1, 2003 which was sent to the non-signing inventor states that copies of the following applications were received: attorney docket numbers P000455, P000462, and P00518.

As the copy of the letter dated December 1, 2003 makes no reference to the instant application, it cannot serve as evidence that a complete copy instant application was provided to the non-signing joining inventor.

Petitioner has also submitted a copy of a letter from the purported counsel of the non-signing joint inventor. Unfortunately, the letter has been so heavily redacted that all it establishes is that the above-mentioned letter of December 1, 2003 was received.

For these reason, the petition under 37 C.F.R. §1.182 is **DISMISSED**.

² See MPEP 409.03(d).

³ The Office will presume that the period is a typographical error.

Petitioner is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Renewed Petition Under 37 C.F.R. §1.182," and should only address the deficiencies noted below, except that the reply may include an affidavit executed by both non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

On renewed petition, petitioner should ensure that a complete copy of the application is sent to the non-signing inventor, or establish that the instant application does indeed have three separate attorney docket numbers (with the first two in use by the same law firm).

The reply to this letter may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as four weeks.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

6 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.